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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,336	09/04/2003	Hyang-Kyun Oh	O2MICRO 99.06 CON2	6108
32047	7590	08/23/2004	EXAMINER	
GROSSMAN, TUCKER, PERREAULT & PFLEGER, PLLC			KIM, PAUL L	
55 SOUTH COMMERICAL STREET			ART UNIT	
MANCHESTER, NH 03101			PAPER NUMBER	
			2857	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,336

Applicant(s)

OH ET AL.

Examiner

Paul L Kim

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 23 is objected to because of the following informalities: In the last line "adapted" should be --adapter--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 recites the limitation "*said* pinout arrangement of *said* second expansion card". Claims 24-26 recites the limitation "*said* first expansion card type". Also claim 24 recites, "*said* passive adapter comprising". There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims ~~21~~ and ~~22~~ are rejected under 35 U.S.C. 102(b) as being anticipated by Potdevin et al.

With regard to claim ~~21~~, Potdevin et al teaches an adapter to read and operate a Smart Card comprising: a housing that receives a smart card and having a pinout

arrangement to interface with a PCMCIA socket (col. 8, lines 14-36) and a circuit that controls signal lines of the pinout to permit a controller to read and operate the smart card through the PCMCIA socket (col. 4, lines 54+).

As best as claim 22 can be interpreted, Potdevin et al teaches an expansion card slot that comprises a PCMCIA Type II/III arrangement (col. 3, lines 60+).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potdevin et al.

With regard to claims 23, 25, and 27, Potdevin et al teaches an adaptor to read and operate a Smart Card comprising: a controller that comprises circuitry for detecting, operating, and providing communications between the card and bus controller using PC card communication protocol (col. 4, lines 54+) and an adapter enabled to provide operability of the smart card in a PCMCIA type II/III socket (col. 3, lines 60+). Potdevin et al teaches separate circuitry used to perform various functions (fig. 1e, parts 40), but does not specify individual circuitry modules for each of the detecting, operating, and communication functions. However it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. (Nerwin v. Erlichman,

168 USPQ 177, 179 (CCPA 1969)) It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Potdevin et al, so that each of the detecting, operating, and communication functions have individual circuitry, in order to derive the benefit of system that can be easily modified or upgraded.

As best as claim 24 can be interpreted, Potdevin et al teaches an adapter comprising a circuitry and a connector with signals being operable through the socket (fig. 1e).

As best as claim 26 can be interpreted, Potdevin et al does not specify an expansion card type being a flash memory card. Klatt et al teaches a PCMCIA housing adaptor that accepts a variety of different cards such as a flash memory card (col. 2, lines 66+). Since Potdevin et al and Klatt et al are both within the art of adapting a PCMCIA socket to accept non- PCMCIA cards, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Potdevin et al, so that a flash memory card can be accepted in the housing, as taught by Klatt et al, in order to derive the benefit of system versatility.

Note: It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Conclusion

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stahl, Knights, and Bates III both teach a smart card adaptor for a PCMCIA socket.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is 571-272-2217. The examiner can normally be reached on Monday-Thursday 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

PK
July 21, 2004


MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800